REMARKS

Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claims 22 and 24-39 under 35 U.S.C. § 112, second paragraph, in the light of the above corrective amendments which are made in an effort to overcome the Examiner's stated grounds in support of this rejection.

Applicant voluntarily cancels "method" claims 22 and 23 without prejudice, and reserves the right to file a Divisional Application further to prosecute these claims.

Even though the method claims 22 and 23 have been canceled, Applicant respectfully reminds the Examiner that use of the passive voice for method steps in method claims is specifically approved by the MPEP, and that there is no specific requirement for a particular format for method (or any other type of claims). As suggested by the Examiner, the words "can be" in claims 24 and 31 have been changed to "are".

Thus, Applicant respectfully requests the Examiner now to **allow claims 24-39**. (Applicant has taken this opportunity to introduce other claim amendments for overcoming possible future 112, 2nd rejections by the Examiner.)

More specifically, the claimed invention is directed to the production of coupons from a continuous web, or from a double-width web, i.e., a double web. Fig. 1 shows the coupon subassembly 14 provided for this purpose. The task of severing coupons from a continuous web, and immediately feeding them for "processing", i.e., in the packaging machine and finally to the packs themselves, requires certain mechanisms in the region of the packaging machine.

Thus, shown in Fig. 1 is a coupon subassembly containing the reels from which the (double) web for the coupons is pulled off. In a subsequent subassembly, coupons of double

width are severed from the web. This operational state is shown in Fig. 4 with the double coupon 15. This coupon is then severed down the middle and transferred to two subsequent belts 23, 24 for further transport by the individual belts. This is followed by elements used for converging the individual belts, which are transported in parallel fashion, to a common belt, namely first to the connection conveyor 28 and finally to the deflecting roller 32. The latter deflects by 90° the conveying direction of the coupons being transported at a distance from one another. In the region of a further belt of a turning conveyor 36, the coupons are fed to their predetermined destination, namely either to an intermediate coupon magazine or directly to the pack.

As already explained, this complex transport process is conducted, and is necessary, for conveying coupons, that have been continuously severed from a web in the region of the packaging machine, directly into a magazine or to transfer them to a coupon feeder 21.

Due to the complex and voluminous design of the coupon subassembly 14 for the processing of continuous material webs, it is necessary to position this subassembly at the rear side of the packaging machine. This corresponds to the illustration in Fig. 1. Due to its constructive design, the front side is occupied by other subassemblies, in particular by subassemblies for producing and feeding packs or sub-packs. The invention succeeds in solving two interactive problems conditioned by the packaging machine shown in Fig. 1:

a) *The coupons, produced in pairs according to the machine performance, must be transported from the rear side of the packaging machine to a front region, namely to the conveying plane of the packs, each of which is to receive a coupon.*

b) *In the region of the plane of pack movement, the coupons must be deflected by 90° as seen in the direction of transport because the packs 10 are transported in a direction transverse to the original direction of coupon transport.*

This simple statement of task results in the complex transport direction for the coupons. The basic elements of independent apparatus claims 24 and 31 can be summarized as follows:

a) the coupons, produced simultaneously in pairs and initially lying adjacent to one another, are spaced apart from each other by being transported at different speeds in the region of the belts 23, 24,

b) the now successive coupons are transferred to a common conveying plane (connection conveyor 28),

c) the individual, successive coupons are then deflected in the upright plane by 90° by means of the deflecting conveyor 32, and

d) afterwards, the coupons are transferred to a turning conveyor 36, which turns the coupons back into the horizontal alignment during their continual transport for further processing.

Such a claimed apparatus is **not taught or suggested** by the prior art.

More specifically, DE 198 41 526 A1 to Heinz Focke et al. is cited in Applicant's IDS, is in the name of the **assignee** of the present application, and shares **inventors in common**. Focke '526 also relates to the transfer of coupons to packs or to a respective "cigarette block" 11 as pack contents.

However, Focke '526 **fails** to teach or suggest a primary feature of Applicant's claimed apparatus. Instead, in Focke '526, individual coupons, pre-manufactured at another site, are placed as a stack in a coupon magazine 24. In accordance with hitherto common practice, the

coupons are industrially pre-manufactured, namely provided with the desired printing, cut to the appropriate size, and then delivered in bundled stacks to the site of further application. There, the stacks of coupons are fed as required by the operating staff into one magazine 24 or another from above.

It is obvious that this prior art method is very time-consuming and inefficient. High-performance (speed) packaging machines require a correspondingly large number of coupons, which means that a considerable amount of work performed by the operating staff is dedicated to feeding the magazine with coupons.

A further problem concerns the efficient and reliable removal of the blanks from one magazine or the other. Fig. 3 of Focke '526 shows the technical measures required for removing the coupons. These measures include the use of a belt conveyor 31 with the deflecting rollers 29, 30, followed by a conveyor with the deflecting rollers 32, 36. Nevertheless, the removal of the coupons is unsatisfactory for high-performance operations, for it is highly prone to error. The coupons are, as a rule, folded, thin-walled blanks that are difficult to handle. It is not possible to ensure with the necessary degree of reliability that only one individual coupon is removed from the magazine in each case. Furthermore, it cannot be ensured that the coupons are provided at the necessary spacing from one another, namely aligned to match the spacing between the packs to be supplied with coupons. A magazine having a mechanical removal device for coupons has been shown to be inefficient and unreliable.

N.B. For this reason, Applicant's novel and non-obvious claimed apparatus employs a coupon subassembly 14 at the machine side in which the coupons are finished (in pairs) on location, namely directly at (the rear side of) the packaging machine.

Examiner Joerger states that in Focke '526 the coupons "are successively produced by the severing of a double coupon". Such statement **cannot be read** from the Focke '526 specification. Rather, as already explained above, the coupons are produced at another site in a large-scale technical process, one that at least does **not** involve the severing of double coupons from a web. An English translation of a passage from DE '526 is enclosed, namely the text in column 3, line 22, to column 4, line 16. The Examiner will note that this passage does not detail the production of the coupons but, rather, merely provides that the coupons are stored in stacks in the coupon magazine.

Applicant notes that the only difference between claims 24 and 31 concerns the transport of the blanks in the area of the intermediate conveyor 27 which is not necessary with the embodiment of Fig. 13/14 (claim 31). The claim 24 embodiment is used when finally single coupons one after the other are to be handled finally either by a magazine 22 as shown in Figs. 3 and 5 or by a single coupon feeder to immediately transfer the single coupons one after the other to packs being transported along a single line. The claim 31 embodiment is suitable for cases where the coupons are being transferred to packages being transported in two lines.

Thus, since the independent claims 24 and 31 clearly are **not readable** on the disclosure of DE '526, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 102(b), and to find the application to be in condition for allowance with all of claims 24-39; however, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

In this regard, Applicant notes that the Examiner has not used the form paragraph 7.02 stating that the claims and/or the disclosure were "so incomprehensible that a reasonable [prior art] search cannot be made" (see MPEP 702.01); thus, Applicant assumes that the Examiner has also made a prior art search of the claims 24-39 (in addition to claim 23). As a precaution, Applicant has shown above why these claims also are not anticipated by DE '526. Certainly, the use of "can be" instead of "are" does not render the claims so incomprehensible that a "reasonable search" of the prior art cannot be made. (Also see MPEP 2171-2172.01 and 2106VA (page 2100-13) requiring an examiner to search the prior art even when claims are rejected under 35 USC, second paragraph, as being "indefinite".)

If, in spite of the fact that the Examiner did not use the required form paragraph 7.02 to specify alleged incomprehensibility (and searchability) of the disclosure/claims, the Examiner did not, in fact, make a prior art search of these claims, then Applicant respectfully requests the Examiner either to withdraw the finality of the present Office Action and issue a new Office Action, or else to issue a corrected Office Action, or else to allow the application.

REQUEST FOR INTERVIEW

If for any reason the Examiner feels that the application is not now in condition for allowance with claims 24-39, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Applicant files concurrently herewith a Petition (with fee) for an Extension of Time of two months. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any

additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: March 1, 2007